



UNITED STATES PATENT AND TRADEMARK OFFICE

EA

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,144	03/05/2002	Victor Markowitz	4009US (43413-276314)	7128

27189 7590 05/31/2006

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
530 B STREET
SUITE 2100
SAN DIEGO, CA 92101

EXAMINER

SKIBINSKY, ANNA

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/090,144

Applicant(s)

MARKOWITZ ET AL.

Examiner

Anna Skibinsky

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: see continuation sheet.


ANDREW WANG

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of Item 3 NOTE:

Claims 1, 8, and 15 appear to incorporate New Matter.

The proposed amendments to the claims involving limitations drawn to "a quality control process" (see lines 6 and 7 of proposed claim 1 and lines 6 and 7 of proposed claim 15) and "a quality control module" (see lines 2-4 of proposed claim 8) are newly presented limitations and as such would require further consideration and search if entered. Further, the proposed amendments introduce substantive changes to proposed claim 1 at lines 8 and 9 drawn to "storing the linked gene expression data, sample data and fragment index in a data warehouse" and to proposed claim 8 at lines 11-15 and claim 15 at line 15 drawn to the limitation of "a staging database" that also would require further search if entered.

The "linking the gene expression data" of claim 1 does not have the same scope as previously recited "linking gene expression measurements in the gene expression data base". Similarly, newly amended "with sample data and a fragment index" is not equivalent in scope and meaning as previously recited "with sample data in the clinical database and information in the fragment index database." Additional New Matter considerations in claim 1 includes the amended phrase "applying quality control process to mask data points within the gene expression data and to enforce a sample completion constraint" which is not equivalent to the pointed to page 39, lines 17-22 in the specification which recite "masking of defective gene fragments on chips or of experimental data and enforcement of the sample completion constraint."

Similarly, the newly amended limitations of claims 8 and 15 are not supported by the tables in the submitted Remarks. For example, support for "loading the linked measurements and data into the data warehouse," is not found. Applicant does point to page 16, lines 1-3 in the specification reciting "loaded with sample, gene expression annotation, and expression data from a staging area where the data is integrated after ..." however, the limitations and scope are not equivalent to what is newly amended.

Continuation of Item 11 NOTE:

The rejections in the previous Office Action mailed 12/02/2005 are maintained for the reasons of record.

Claims 1, 4, 5, 8, 11, 12, 18, and 19 are rejected under 35 USC 102(b) as being anticipated by Bassett et al. and 103(a) as being obvious over Bassett in view of Gopalkrishnan et al. Applicants arguments are directed to amendments to the instant claims which have not been entered onto the record. If the after final amendment submitted by applicants were entered, the amendments to the instant claims would not be sufficient to overcome the prior art rejection of Bassett et al. Bassett et al. teach a program for determining well characterized organisms, wherein functional information that may be incomplete and lack knowledge about the expression of genes (page 54, col. 1, lines 12-28) may be followed by statistical analysis that can be applied to detect or extract internal structure from data (page 54, col. 2, lines 29-41). The prior art thus reads on the newly amended limitation of Claim 1, reciting "applying quality control process to mask defective points within genetic expression data and to enforce sample completion constraint". Claims 8 and 15, have similar newly added limitations.

Claims 1, 8, and 15 are rejected under 35 USC 112, 1st paragraph as being NEW MATTER. Applicants have pointed to page 34, lines 6-9 which provides adequate support for the previous amendment of "staging comprises linking gene expression measurements in the gene expression database with the sample data in the clinical database and information in the fragment index database." Applicant's Remarks (page 130) is sufficient to overcome the New Matter rejection in the previous Office Action.

Continuation of Item 13 NOTE:

The submission of a replacement set of drawings in the instant application is acknowledged. the submitted replacement drawings would be sufficient if the after final amendment was entered.



ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600